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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,351	06/15/2001	Won-Il Jung	45323/DBP/Y35	8658
23363	7590	01/12/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Applicati n N .</b> 09/882,351	<b>Applicant(s)</b> JUNG, WON-IL	
	<b>Examiner</b> Elena Tsoy	<b>Art Unit</b> 1762	

**--The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --**

THE REPLY FILED 03 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 2, 4, 7-14, 17-23.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). of 1/3/05.
10. ☐ Other: \_\_\_\_\_

***Advisory Action***

1. The amendment filed on January 3, 2005 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record as set forth in the Final Office Action mailed on August 26, 2004. Claims 1, 2, 4, 7-14, 17-23 are pending in the application.

***Response to Arguments***

2. Applicants' arguments filed January 3, 2005 have been fully considered but they are not persuasive.

(A) Applicants argue that in the Final Rejection dated August 26, 2004, the examiner rejects claims 1, 2, 4, 7-14 and 17-23 under 35 U.S.C. j 103(a) as allegedly unpatentable over Rourke et al. (U.S. Patent No. 4,720,910) in view of Shackle (U.S. Patent No. 6,174,623). In making this rejection, the examiner admits that Rourke fails to teach that the conductive filler can comprise a combination of carbon black and a second conductive polymer, as presently claimed. To remedy this deficiency, the examiner relies on a statement in Shackle that a co-pending application (U.S. Patent No. 5,418,089 to Chaloner-Gill, et al.) discloses the replacement of carbon black with a conductive polymer. However, Chaloner-Gill expressly states that "the conductive polymer replaces *all* of the typically present electroconductive material including, by way of example, graphite, powdered carbon, powdered nickel, metal particles and the like." (Column 7, lines 11). Accoringly, Chaloner-Gill neither teaches nor suggests the partial replacement of carbon with a conductive polymer. Rather, Chaloner-Gill expressly teaches away from such a partial replacement.

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The Examiner respectfully disagrees with this argument. Rourke et al is a primary reference showing that a **mixture** of ionically conductive material (polyethylene oxide containing an inorganic salt) and electroconductive filler such as **carbon black** can be used. Chaloner-Gill is a secondary reference which shows that *all* carbon black can be replaced with a conductive polymer. In other words, according to Chaloner-Gill, carbon black is functionally equivalent to the conductive polymer for their use as electroconductive material.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced *all* carbon black filler in Rourke et al with a conductive polymer since Chaloner-Gill, carbon black is functionally equivalent to the conductive polymer for their use as electroconductive material.

It is held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....

Therefore, it would have been obvious to one of ordinary skill in the art to have used *either* carbon black alone, a conductive polymer alone, or a **mixture** of carbon black and a conductive polymer (i.e. partially replaced) with the expectation of providing the desired electroconductivity since Chaloner-Gill teaches that carbon black is functionally equivalent to the conductive polymer for their use as electroconductive material.

(B) Applicants argue that contrary to examiners' statement, Amano et al suggests that the carbon black and a conductive polymer two materials may be used as alternatives to one another.

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Even if Amano et al suggests that the carbon black and a conductive polymer ~~two materials~~ are used as alternatives to one another, combination of two is obvious for the same reasons as was discussed above with Chaloner-Gill.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Examiner  
Art Unit 1762

ELENA TSOY  
PRIMARY EXAMINER



January 10, 2005